

REMARKS

Claims 1-13 are pending. Claims 7 and 9 have been withdrawn from consideration by the Examiner for being drawn to a non-elected species. By this Amendment, Claims 1 and 8 are amended and Claims 10-13 added. Applicants respectfully submit that no new matter is presented herein.

Claim Rejection -- 35 U.S.C. §102

Claims 1-6 and 8 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,934,397 to Schaper. Applicants respectfully traverse the rejection.

Claim 1 recites a hybrid vehicle including an engine for driving main driving wheels; and a plurality of motors for driving sub driving wheels, wherein a speed reduction member is disposed between the sub motor and the main motor, and wherein at least one motor is selected from the plurality of motors to drive the sub driving wheels according to a driving force required by the vehicle.

The Office Action states Schaper discloses a speed reduction (not shown, col. 6, lines 47-48) which is ***disposed between*** the sub motor and the main motor.

Applicants have reviewed the cited passage of Schaper, as well as the remainder of the reference, and are unable to locate any such disclosure or suggestion.

Rather, column 6, lines 47-48 of Schaper states "each motor 34, 36, 38 is independently connected to batteries 32 and a speed controller (not shown)." Applicants presume the Office Action is asserting that the mentioned speed controller, which is not shown by Schaper, corresponds to the speed reduction member recited by Claim 1. Regardless, Applicants respectfully submit the cited passage clearly states that each motor 34, 36, 38 of Schaper is independently connected to the batteries 32

and the speed controller, but nowhere does Schaper teach or suggest the speed controller is disposed between the main motor 36 and either one of the sub motors 34. One of ordinary skill in the art could understand the cited passage to indicate that each motor 34, 36, 38 is independently connected to the batteries and the speed controller. In other words, each motor 34, 36, 38 is separately and independently connected to the speed controller.

Yet, the Office Action appears to be arguing the speed controller (which is not shown) of Schaper is inherently disposed between the main motor 36 and one of the sub motors 34. Applicants note that while such a structure is possible, nothing in the written disclosure of Schaper indicates such a structural arrangement. Further, Applicants respectfully submit that the location of the speed controller not shown by Schaper is not required to be located between the main motor 36 and one of the sub motors 34. In other words, it is not a fact that is inherent in the disclosed structure of the Schaper hybrid vehicle to have the speed controller disposed between the main motor 36 and one of the sub motors 34. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. See *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Put simply, the fact that the speed controller or any speed controller can be disposed between the main motor 36 and one of the sub motors 34 of the Schaper hybrid vehicle is not sufficient to establish inherency of such a feature actually or factually be located therebetween. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would so be recognized by persons of ordinary

skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See *In re Robertson*, 160 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). See M.P.E.P. § 2112 (IV).

Put simply, Schaper fails to disclose or suggest, either expressly, implicitly, or inherently, the speed controller being located between the main motor 36 and one of the sub motors 34. As such, Schaper fails to disclose or suggest each and every feature recited by Claim 1.

To qualify as prior art under 35 U.S.C. §102, a single reference must teach, i.e., identically describe, each feature of a rejected claim. As explained above, Schaper does not disclose or suggest each and every feature recited by Claim 1. Therefore, Applicants respectfully submit that Schaper does not anticipate or render obvious the subject matter recited by Claim 1. Accordingly, Applicants respectfully submit Claim 1 should be deemed allowable over Schaper.

Claims 2-6, 8 and 10-13 depend from Claim 1. It is respectfully submitted that these dependent claims be deemed allowable for the same reasons Claim 1 is allowable, as well as for the additional subject matter recited therein.

Applicants respectfully request withdrawal of the rejection.

As noted in the Response to Restriction Requirement filed on April 22, 2005, Applicants submit Claim 1 is a generic claim. Upon the allowance of generic Claim 1, Applicants respectfully request reconsideration and rejoinder of non-elected Claim 7 and 9 as provided by 37 C.F.R. §1.141.

Conclusion

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejection, rejoinder of Claims 7 and 9, allowance of Claims 1-13, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing docket number 107355-00087**.

Respectfully submitted,



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